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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,047	03/15/2004	Frank Anthony Ruiz	13094-00006	1238

7590 11/22/2005

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EXAMINER
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RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/801,047

Applicant(s)

RUIZ, FRANK ANTHONY

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/21/04, 10/27/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 8, 15, 22, 29, 36, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the dependent claims, the amount of the filler component cannot exceed 50 wt % since the independent claim states that the polyester is present is present in an amount of at least 50 wt %.

### ***Preliminary Remarks***

2. It is noted that the transitional phrase “composed of” recited in claims 18, 25, 32, and 39 can be interpreted in the same manner as either “consisting of” or “consisting essentially of,” depending on the facts of the particular case. See *AFG Industries, Inc. v. Cardinal IG Company*, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001) (based on specification and other evidence, “composed of” interpreted in same manner as “consisting essentially of”); *In re Bertsch*, 132 F.2d 1014, 1019-20, 56 USPQ 379, 384 (CCPA 1942) (“Composed of” interpreted in same manner as “consisting of”; however, court further remarked that “the words composed of” may under certain circumstances be given, in patent law, a broader meaning than consisting of.”). Given that no other film or product components other than the composition is disclosed, the examiner has interpreted the term ‘composed’ to read as “consisting of”.

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3. It is further noted that 150 mesh is a particle size range that includes a maximum particle size of 106 microns.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5-10, 18-24, and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Morita et al (US 5,340,646).

Morita et al discloses a porous film (claim 1) comprising 100 parts of polylactic acid-based resin composition (col. 2, line 48 to col. 3, line 18) and 40-250 parts by weight (col. 6, lines 18-28) of a finely-powdered filler (col. 5, lines 52-64) having an average particle size of from 0.3-4 microns. See Table 3 for exemplified finely-powdered filler.

In light of the above, it is clear that Morita et al anticipates the presently cited claims.

5. Claims 1-45 are rejected under 35 U.S.C. 102(a) or 102(e) as being anticipated by Khemani et al (US 6,573,340, cited on IDS dated 10/27/2005).

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Examples 8-12 in col. 23 of Khemani et al disclose films which were made from a composition comprising Biomax 6926, Ecoflex F, talc, titanium dioxide, and calcium carbonate, wherein Ecoflex is an aliphatic-aromatic copolyester and Biomax 6926 is a hydro/biodegradable resin as taught by applicant on page 6, paragraph 24. The fillers are all disclosed to have a particle size of less than 2 microns.

In light of the above, it is clear that Khemani et al anticipates the presently cited claims.

6. Claims 1-17 and 32-45 are rejected under 35 U.S.C. 102(a) or 102(e) as being anticipated by Nozaki et al (US 2004/0034121).

Nozaki et al discloses a biodegradable resin composition comprising biodegradable resin (paragraphs 0019-0029) and 5-50 mass % of at least one filler having a particle diameter preferably within the range of 1-50 microns (0aragraphs 0030-0036), wherein the composition is formed into a molded product (paragraphs 0055-0058). Note Table 1 for exemplified compositions.

In light of the above, it is clear that Nozaki et al anticipates the presently cited clams.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khemani et al (US 6,573,340, cited on IDS dated 10/27/2005).

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Khemani et al discloses a biodegradable polymer composition suitable for films comprising both stiff and flexible biopolymers (claims 2-6) and optionally 5-95 wt % of the polymers (col. 15, lines 58-60; col. 16, lines 3-17) solid inorganic fillers (col. 15, lines 11-30) having a particle size of 0.01 microns to 2 mm (col. 14, lines 40-55) with an exemplified particle size of 4 microns or less (col. 15, lines 43-44). Note Examples 8-12 in col. 23.

While Kemani et al exemplifies the use of some fillers in certain amounts, Kemani et al fails to exemplify or specifically disclose each and every one of the presently claimed inventions, nevertheless, given the general teachings of Kemani et al, it would have been obvious to one of ordinary skill in the art to utilize higher amounts of inorganic and other suitable sizes of said filler and thereby arrive at the presently claimed invention.

8. Claims 1-4, 7-11, 14-18, 21-25, 28-32, 35-39, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grigat et al (US 5,827,905) in view of Wypych (*Handbook of Fillers*).

Grigat et al discloses reinforced thermoplastic molding compositions comprising biodegradable aliphatic or partially aromatic polyesters (col. 1, lines 34-60) and 1-80 wt % of mineral fillers such as wollastonite and kaolin (col. 5, lines 7-12), wherein the composition is extruded into films and other molded products (col. 6, lines 15-20).

Grigat et al is silent with respect to the size of the wollastonite and kaolin mineral fillers.

Wypych discloses typical particle size and sieve analysis for wollastonite and kaolin. In particular, wollastonite is described as having a particle thickness of 1-50 microns which leaves 0.09-3 % 325 mesh sieve residue (page 167) and kaolin is described as having a particle size of 0.2-7.3 microns which leaves 0.01-2 325 mesh sieve residue (page 99).

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Given that Grigat et al teaches the use of wollastonite or kaolin as the mineral filler and further the teachings regarding typical sizes of wollastonite and kaolin fillers, it would have been obvious to one of ordinary skill in the art to utilize a conventional filler with a conventional size in the composition of Grigat et al and thereby arrive at the presently cited claims.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

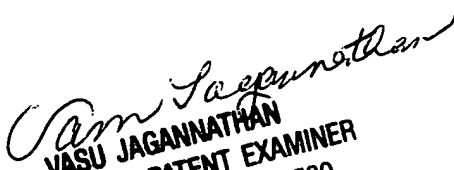
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/15/2005

vr



  
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